REMARKS

Claims 1-51 are pending, of which claims 19-43 and 49 have been withdrawn from consideration. By way of the present amendment, claims 44-48, 50 and 51 have been cancelled.

Claims 1-18 remain uncancelled and under consideration.

Claims 1-7, 15-18, 44-48, 50 and 51 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 6,627,918 (Getz) in view of U.S. Pat. No. 6,245,469 (Shiba). Applicants disagree. Without acquiescing, the cancellation of claims 44-48, 50 and 51 render this rejection applicable only to claims 1-7 and 15-18, and Applicants address their remarks accordingly.

Claims 1-18 recite ink jet printing and hardening a plurality of dots on a conductive coating to make spacer dots for a touch screen. Getz discloses a resistive touch sensor having spacer dots made by screen printing. Getz does not disclose ink jet printing. Shiba discloses making spacers using ink jet techniques, the spacers incorporated into color filter elements for liquid crystal displays.

To make a prima facie case of obviousness using multiple references, both a motivation to combine the references and reasonable expectation of success must exist. In this case, there is no motivation to combine Getz and Shiba, nor is there reasonable expectation of success. The rejection seems to rely on the mere fact that ink jet printing exists as a technique to make elements called "spacers," and so it would be obvious to use such a technique to make the spacer dots described in Getz. This is akin to an "obvious to try" argument, which does not rise to the level required to make a prima facie case of obviousness. As Applicants discuss throughout their Specification, touch panel spacer dots are subjected to repeated applied forces and rubs, conditions that are not experienced by display element spacers including those disclosed by Shiba. Touch panel spacer dots are formed on the touch-functional conductive layers of the touch panel, materials onto which the spacers of Shiba are not formed. Further, Shiba relies on the use of through-holes into which the ink jet material is injected so that the size of the spacers can be controlled. Such provisions are generally not available or desirable when patterning spacer dots for touch panel devices. As such, there is nothing in Shiba that would suggest to one of skill in the art that any of the materials or techniques for making color filter spacers would be

applicable to the making of touch panel spacer dots. In addition, there is no teaching or suggestion that the spacer dot materials disclosed by Getz would be suitable, or modifiable to be suitable, for ink jet printing. It is Applicants view that hindsight has been used impermissibly in making the present rejection, thereby ignoring the significant advancements offered by Applicants in the present invention of ink jet printing touch panel spacer dots.

For these reasons, Applicants submit that there is no motivation to make the proposed combination of references, and that there would be no reasonable expectation of a successful outcome even if such a combination were made. Therefore, Applicants submit that a prima facie case of obviousness had not been made, and request reconsideration and withdrawal of the rejection of claims 1-7 and 15-18 over Getz in view of Shiba.

Claims 8-14 stand rejected under 35 USC 103(a) as being unpatentable over Getz in view of Shiba and in further view of USSN 09/756,312 (which is now U.S. Pat. No. 6,883,908 to Berman). Applicants disagree.

Berman offers nothing to cure the deficiencies noted above with respect to the proposed combination of Getz with Shiba, and as such a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of this rejection.

Applicants submit that claims 1-18 are in condition for allowance and request early indication of the same.

Respectfully submitted,

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